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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,458	12/21/2001	Travis J. Parry	10019040-1	5480

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EXAMINER

PARK, CHAN S

ART UNIT	PAPER NUMBER
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2625

DATE MAILED: 05/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/029,458	PARRY ET AL.	
	Examiner	Art Unit	
	CHAN S. PARK	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-8,10,11,13-16 and 23-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-8,10,11,13-16 and 23-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

DOUGLAS Q. TRAN
PRIMARY EXAMINER

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. Currently, **claims 1, 3, 5-8, 10, 11, 13-16 and 23-37** are pending.

Claim Objections

2. Claim 23 is objected to because of the following informalities:

Line 4, "is" should be -- its --;

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 31-37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The descriptions or expressions of the claimed programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed programs do not define any structural and functional interrelationship between the program and other claimed elements of a computer which permit the program's functionality to be realized.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 11 and 16 recite the limitation "unprotecting it" or "translating it". There is insufficient antecedent basis for this limitation in the claim. It is uncertain if "it" is referring to different document. For the examining purpose, it is construed as any document in the received by the portable computing device.

5. Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim recites that the printing device comprises a processing device. It is uncertain as to what this processing device does. Is this referring to the printing engine?

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-8, 10, 11, 13-16 and 23-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanimoto U.S. Patent No. 6,963,419 in view of Sugiyama U.S. Patent No. 6,965,958.

6. With respect to claim 6, Tanimoto teaches a method for facilitating secure printing comprising:

receiving with a computing device (client computer 4) a protected document from a nearby printing device (facsimile server including a network printer 1 in col. 5, lines 4-9); and

unprotecting the document on the computing device (col. 10, lines 52-55).

Tanimoto, however, does not explicitly teach that the computing device is a portable computing device and the step of transmitting the unprotected document from the portable computing device back to the printing device so that the printing device can generate a hard copy of the document.

Examiner takes an Official Notice that replacing the client computer with a laptop or PDA for computing and displaying image data is well known in the art. Thus, it would have been obvious to use a laptop or PDA so that the user can carry the computing system anywhere.

Furthermore, Sugiyama, teaches a method of transmitting document to a selected printing device so that the printing device can generate a hard copy of the document (fig. 9).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the method of selecting the printing device to print the image data displayed in the computer of the Tanimoto.

Therefore, it would have been obvious to combine Tanimoto with Sugiyama to obtain the invention as specified in claim 6.

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7. With respect to claim 7, it is further well known in the art that the laptop or PDA communicates with other device via wireless communication. Thus, it would have been obvious to obtain the invention as specified in claim 7.

8. With respect to claim 8, Tanimoto teaches the method, wherein receiving the protected document comprises receiving an encrypted document and wherein unprotecting the document comprises decrypting the document (col. 10, lines 52-55 and fig. 1).

9. With respect to claim 10, Tanimoto teaches the method, wherein receiving the protected document comprises receiving a protected, untranslated document (sending/receiving the encrypted document in fig. 1).

10. With respect to claim 11, the combination of Tanimoto and Sugiyama teaches the method of claim 10, further comprising translating the document into a print ready format after unprotecting it. It is inherent that the either the printer/client must put the document into the print ready format (decrypted form) in order to print the document by the printer.

11. With respect to claim 13, Tanimoto teaches a method for facilitating secure printing, comprising:

receiving with a computing device an untranslated document (encrypted document) from a nearby printing device; and

translating the document into a print ready format (decrypted document) on the computing device.

With respect to rest of the claim, arguments analogous to those presented for claim 6, are applicable.

12. With respect to claim 14, arguments analogous to those presented for claim 7, are applicable.

13. With respect to claim 15, arguments analogous to those presented for claim 10, are applicable.

14. With respect to claim 16, arguments analogous to those presented for claim 11, are applicable.

15. With respect to claim 23, Tanimoto discloses a printing device, comprising:
a processing device (fig. 2);
memory including a security manager that is configured to facilitate transmission of a document that cannot be printed in its present form (encrypted document) to a nearby computing device.

With respect to rest of the claim, arguments analogous to those presented for claim 13, are applicable.

16. With respect to claim 24, arguments analogous to those presented for claim 7, are applicable.

17. With respect to claim 25, arguments analogous to those presented for claim 6, are applicable.

18. With respect to claim 26, arguments analogous to those presented for claim 8, are applicable.

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19. With respect to claim 27, arguments analogous to those presented for claim 7, are applicable.
20. With respect to claim 28, arguments analogous to those presented for claim 13, are applicable.
21. With respect to claim 29, arguments analogous to those presented for claim 8, are applicable.
22. With respect to claim 30, arguments analogous to those presented for claim 7, are applicable.
23. With respect to claim 34, arguments analogous to those presented for claim 6, are applicable.
24. With respect to claim 35, arguments analogous to those presented for claim 8, are applicable.
25. With respect to claim 36, arguments analogous to those presented for claim 13, are applicable.
26. With respect to claim 37, arguments analogous to those presented for claim 8, are applicable.

Claims 1, 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanimoto in view of Kageyaman et al. U.S. Patent No. 6,567,180 (hereinafter Kageyaman), and further in view of Sugiyama.

27. With respect to claim 1, Tanimoto teaches a method for facilitating secure printing, comprising:

receiving with a printer a document to printed (fig. 1); and
transmitting the document from the printer to a nearby computing device (fig. 1);
and
converting the document into a print ready version of the document by the
computing device (col. 10, lines 52-55).

Tanimoto, however, does not explicitly teach that the computing device is a portable computing device and the printer receives an untranslated document. Further, the step of sending a print ready version of the document from the nearby portable computing device to the printer is not explicitly taught.

As noted above, examiner takes an Official Notice that replacing the client computer with a laptop or PDA for computing and displaying image data is well known in the art. Thus, it would have been obvious to use a laptop or PDA so that the user can carry the computing system anywhere.

Kageyaman, the same field of the network printing art, teaches steps of receiving with a printer an untranslated document (PDL documents) to be printed (col. 6, lines 52-65) and determining on the printer that the document cannot be printed in its present form (col. 16, lines 63-67).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the method of receiving PDL documents of Kageyaman into the network printer of Tanimoto.

The suggestion/motivation for doing so would have been to securely transmit the document by encrypting the PDL documents so that an authorized party can securely display the documents stored in the printer.

Furthermore, Sugiyama, teaches a method of transmitting document to a selected printing device so that the printing device can generate a hard copy of the document (fig. 9).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the method of selecting the printing device to print the image data displayed in the computer of the Tanimoto.

Therefore, it would have been obvious to combine three references to obtain the invention as specified in claim 1.

28. With respect to claim 3, Tanimoto teaches the method of encrypting the received document (fig. 1).

29. With respect to claim 5, it is further well known in the art that the laptop or PDA communicates with other device via wireless communication. Thus, it would have been obvious to obtain the invention as specified in claim 7.

Contact Information

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571) 272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

csp
May 15, 2006

Chan S. Park
Examiner
Art Unit 2625

Chan S. Park

DOUGLAS TRAN
EXAMINER
Douglas Tran